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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/923,923

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Richard D. Martin

401-13U1

9008

570 7590 10/31/2007
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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2154

MAIL DATE

DELIVERY MODE

10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/923,923

Applicant(s)

MARTIN ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for examination. Claims 13-24 are examined. Claims 1-12 have been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/04/2007 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 13-24 are rejected under 35 U.S.C. 102(e) as being unpatentable as being anticipated by Pettersen et al (US 6,826, 594) (hereinafter Pettersen).

5. As per claim 13, Pettersen teaches a method of constructing a web page that allows for syndication of digital assets, the method comprising:

(a) constructing a web page (fig 2); and

(b) inserting into the web page script associated with at least one digital asset (fig 2, col 4, lines 11-28) that is desired to be part of a fully rendered web page (fig 2), wherein the script, when executed by a browser, requests the content of the digital asset from a remote site (fig 2, col 8, lines 6-30), the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content (fig 2, col 8, lines 6-30).

6. As per claim 14, Pettersen teaches the script is JavaScript (fig 2, col 8, lines 6-30).

7. As per claim 15, Pettersen teaches a method of claim 13 wherein the selected content is an executable file (98, fig 2).

8. As per claim 16, Pettersen teaches a method of claim 13 wherein the script includes a subscriber identifier and a content identifier, which together, create the unique identifier of the selected content (col 27, line 15).

9. Claims 17 and 21 do not teach or define any new limitations above claim 13 and therefore are rejected for similar reasons.

10. Claims 18 and 22 do not teach or define any new limitations above claim 12 and therefore are rejected for similar reasons.

11. Claims 19 and 23 do not teach or define any new limitations above claim 15 and therefore are rejected for similar reasons.

12. Claims 20 and 24 do not teach or define any new limitations above claim 16 and therefore are rejected for similar reasons.

Response to Arguments

13. Applicant's arguments filed 09/04/2007 have been fully considered but they are not persuasive, therefore rejections to claims 13-24 is maintained.

14. 35 U.S.C. 101 rejection to claims 17-20 have been withdrawn.

15. In response to applicants argument regarding the affidavit filed on 01/04/2007 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the Pettersen reference in the 35 U.S.C. 102(e) rejection of claims 13-24 as set forth in the March 08, 2007 Office action.

GENERAL CONSIDERATIONS

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713,

184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07)

Applicant attempts to establish prior invention by showing Reduction to Practice (RTP) of the invention prior to the July 15, 2000, the effective filing date of Pettersen. What must be shown to have been reduced to practice is the CLAIMED invention.

REDUCTION TO PRACTICE

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See MPEP 715.07.

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. (See MPEP 2138.05).

In order to establish prior invention, the evidence must show that the ***claimed invention*** is what was reduced to practice prior to the date of the reference sought to be antedated.

Applicants have submitted an affidavit regarding a demonstration of some Syndication source code by **author Activedatax.com** prior to July 15, 2000. Applicant relies on statements in the affidavit and the supporting exhibits to establish reduction to practice of the claimed invention.

As will be explained in detail below, the affidavit and supporting exhibits are not sufficient to prove reduction to practice.

In general, the affidavit is not at all clear as to how the Exhibits support "method of constructing a web page that allows for syndication of digital assets, (a) constructing a web page; and (b) inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page, wherein the script, when executed by a browser, requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content. " of the ***claimed invention***. Applicant is relying on an Appendix A source code to show "Reduction to Practice". The Appendix A, at best, this document may only be able to establish conception of retrieving content from the Publisher server. Applicant is requested to show the client-side script in EXIHIBIT A to requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content.

Although the declarations allege specific facts, there is no clear explanation as to how the supporting affidavits establish those facts. The Examiner's review does not find support for the elements attempted to prove by the Exhibits.

Furthermore, Applicant failed to provide evidence to show the claimed limitation of "the selected content is an executable file" (claims 15,19, 23) and the claimed limitation of "inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page" as in claim 13.

Thus applicant has failed to provide a CLEAR explanation of how the exhibits support the reduction to practice of the claimed invention, in the sense that it is not clear whether the Exhibits even support the conception of the invention at issue.

Note, that this is merely one example of the lack of clear explanation. The burden is on applicant to provide a proper declaration and supporting exhibits in order to establish prior invention.

Proof of actual reduction to practice requires a showing that the apparatus existed and worked for its intended purpose. A written description does not constitute an actual reduction to practice. Furthermore only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice.

A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice. Accordingly, applicant has not established prior invention. The rejection is maintained.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Pettersen reference to either a constructive reduction to practice or an actual reduction to practice.

EXHIBIT 1: Syndication Source Code shown in Appendix A (pages A1-A8) of the present specification, as evidenced by the last changed date on page A1 of 11/9/99.

EXHIBIT 2: Document entitled "Affiliate Setup Instructions.", date modified 2/3/2000.

Provisional Application filed August 7, 200.

Applicant failed to show any activity between 11/9/99 to 2/3/2000 and between 2/3/2000 and 8/7/2000.

Accordingly, applicant has not established prior invention. The rejection is maintained.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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NATHAN FLYNN
SUPERVISORY PATENT EXAMINER

